

REMARKS

After entry of the foregoing amendment, claims 1-36 are pending in the application.

A restriction requirement was issued, to which applicant telephonically responded by electing to prosecute claims 1-15, with traverse.

It is not clear that the Office has met its *prima facie* burden of showing that the respective sets of claims are both independent and distinct. Moreover, even if the claims are independent and distinct, it is not believed that maintaining all claims in a single application would be unduly burdensome on the Office. Accordingly, withdrawal of the restriction requirement is solicited.

If the restriction requirement is made final, applicants authorize the Examiner to cancel the non-elected claims by Examiner's Amendment.

Dependent claims 27-36 are newly added. Support for the "home" limitation is found, e.g., at page 15, line 5. Support for the other limitations in these claims is found at page 13, line 25 – page 14, line 32.

Claims 1-15 stand rejected under § 112, paragraph 1. The rejection is respectfully traversed. The implementation of the claimed arranged is technically within the capabilities of an artisan in the field to which the claims relate.

The rejection is based in part on the assertion:

How can one skilled in the art make and use the invention unless it can be guaranteed that a given government agency will permit an individual to electronically request and access his or her own archived photo[?]. The specification does not describe any example government agency that, at the time of filing, would permit such a system.

Enablement does not require a "guarantee" of government permission, as required by the Office. (If the invention was an airplane that flies cross-country in 30 minutes, at 50 feet above the ground, its patentability is not negated by government regulations that prohibit aircraft flight at this altitude. Likewise, if the invention is the use of LSD as a

treatment for Alzheimer's disease, the method is not made unpatentable because the government prohibits doctors from prescribing LSD.)

(Moreover, the Office's doubt about "the question of the cooperation of the government agency" seems ill-founded, as shown by Citibank's demonstrated ability to procure images from California's DMV photo archive.)

The proper inquiry is whether the specification is whether the specification is *technically* enabling – not whether the invention is legally enabled.

As to the matter of *technical* enablement, the Action repeatedly focuses on the "government" aspect of the invention. However, an artisan would recognize that an image archive (e.g., database) is the same, whether it is maintained by a state DMV, or by Google. (Security protocols are familiar to artisans in all manners of databases, and compliance with any security protocols is a matter within the capability of an artisan in the field to which the invention relates.) The claimed "contacting," "soliciting," "receiving," and "printing" are all acts within the technical capability of an artisan in the field to which the claims relate.

The Board will not sustain the § 112 rejection.

Claims 1, 2, 3, 5, 10 and 11 stand rejected as anticipated by the Citibank prior art. However, Citibank does not teach, *e.g.*, an individual user electronically contacting a governmental agency.

The Office somehow construes Citibank as the "individual user" required by the claim. However, this is clearly an incorrect distortion of the claim language.

Three days after the present Action was mailed, the Federal Circuit issued a precedential opinion (*In re Johnston*) that applied the principles of *Phillips v. AWH* to examination – requiring the Office to give claim terms the meanings imparted by applicant's specification, rather than other possible meanings.

When "individual user" is construed in light of applicants' specification, it will be seen that Citibank is clearly not encompassed.

Moreover, if "individual user" is anticipated by Citibank, then it is an image of *Citibank* that would be solicited from the archive. Yet this is not what the prior art shows.

Such errors are repeated in rejections of the other claims. For example, Citibank is said – in claim 2 – to be the "equivalent" of the individual user. But a § 102 rejection does not extend to "equivalency." Likewise, claim 11 requires receiving a request "from an individual user."

Citibank is not an "individual user."

Again, the Board will not sustain such rejections.

Claims 4, 6-9 and 12-15 are rejected under § 103 over Citibank in view of Rhoads (5,841,886).

The same failings of the Citibank art noted above apply equally to all of these further claims. Citibank is not an individual user. Or if it were, the art does not teach soliciting an image of Citibank from the image archive.

Again, the Board will not sustain such rejections.

The foregoing points are believed sufficient to establish that all claims are patentable over the art. Accordingly, applicants do not further belabor this response by additional remarks on the rejections, the art, or the claims – all of which are reserved for possible later presentation.

The claims are in condition for allowance; action to that end is respectfully solicited.

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Respectfully submitted,

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